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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,811	07/27/2000	Kotaro Oami	5000-4777	9671

7590

08/12/2003

Alfred L Haffner Jr
Morgan & Finnegan LLP
345 Park Avenue
New York, NY 10154

EXAMINER

RHEE, JANE J

ART UNIT

PAPER NUMBER

1772

15

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-15

Office Action Summary

Application No.

09/626,811

Applicant(s)

OAMI ET AL.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/13/03 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 7-14 are rejected under 35 U.S.C. 102(b) as being unpatentable by Keng (5362540).

Keng discloses a resin panel body (figure 2 number 11), an insert film (figure 2) arranged on a surface of the resin panel body (figure 2 number 11), the insert film comprising a resin film (figure 2 number 14), a first binder layer formed on the surface of the resin film (figure 2 number 19), a printed part formed on the first binder layer (figure 2 number 10), a second binder layer formed so as to seal the printed part in co-

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operation with the first binder layer (figure 2 number 18) and the second binder layer contacting the first binder layer along a periphery of the printed part (figure 2 number 18, 19). Keng discloses that the resin panel body is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer (figure 2 number 14 and 19). Keng discloses that the second binder layer covers the periphery of the first binder layer to directly adhere closely to the resin film (figure 2 numbers 18,19 col. 3 lines 6-8), the resin panel body directly adheres closely to the resin film on an outer side of the periphery of the second binder layer (figure 2 number 18,12). Keng discloses that the material of the resin panel body is the same as that of the resin film, which is polycarbonate (col. 2 line 67). Keng discloses that the periphery of the second binder layer is printed to overlap the periphery of the first layer (figure 2 numbers 18 and 19). Keng discloses that the printed part is coated along the periphery of the insert film (figure 2 number 10).

As to the claim wherein the resin panel is a window for automobiles, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process

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claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation wherein the resin body is integrally molded with the insert film by inserting molding so that a surface of the resin film of the insert film at the side on which a printed part is formed faces an inside of the resin panel is a method of production and therefore does not determine the patentability of the product itself.

Response to Arguments

2. Applicant's arguments filed 6/13/03 have been fully considered but they are not persuasive.

In response to applicant's argument that Keng does not disclose "a first binder layer formed on the surface of the resin film", Keng does disclose "a first binder layer formed on the surface of the resin film (figure 2 number 19 and 14)." In figure 2 the

element number 19 is the first binder and the element 14 is the resin film and as shown in figure 2 the first binder is formed on the surface of the resin film.

In response to applicant's argument that Keng does not teach or suggest a printed part "formed on " a first binder layer, the document 10 which has printing on it is inserted between the two binder layers, however the ink of the document is pressed on to the first binder layer therefore has a printed part "formed on" the first binder layer.

In response to applicant's argument that Keng does not teach or suggest a second binder layer formed to seal the printed part in co-operation with the first binder layer, Keng does teach that a second binder layer formed to seal the printed part in co-operation with the first binder layer in figure 1, the first binder layer is number 19 and the second binder layer number 18 and seals the printed part which is number 10 in col. 3 lines 7-8 where the two sheets are joined at three edges.

In response to applicant's argument that the resin panel body and the first binder is referred to the same element number, the resin panel body is number 11 in figure 2 and the first binder is number 19 in figure 2, the examiner made a mistake pointing out the correct number to the element in figure 2 due to difficulty of figuring out which portion of the figure the element numbers are pointing to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for

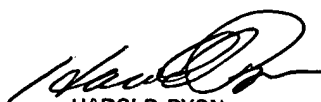
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the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee
August 4, 2003



HAROLD PYON
SUPERVISORY PATENT EXAMINER

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